UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/407,666	09/28/1999	David Simon	17887-31US	3035

20350 7590 09/23/2003

TOWNSEND AND TOWNSEND AND CREW, LLP
TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834

EXAMINER
TREMBLAY, MARK STEPHEN

ART UNIT	PAPER NUMBER
2827	

DATE MAILED: 09/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/407,666	SIMON, DAVID	
	Examiner	Art Unit	
	Mark Tremblay	2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Peri d for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 October 2002* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-23* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-23* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Applicati n Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 9 .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

Applicant: Simon

Filing date: 9/28/99

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

Claims 1, 4-11, and 18-21 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent #6,064,979 to Perkowski. ("Perkowski" hereinafter). Perkowski discloses method of obtaining information related to a specific product from multiple remote databases accessible over the Internet via a communications server using a personal communication device (PCD), said PCD having a display and means for communicating with the communication server, the method comprising the steps of:

a) entering product information into said PCD (see column 3, line 45 to column 4, line 4);

b) transmitting the product information to the communication server from the PCD (see column 3, line 45 to column 4, line 4);

c) transmitting a search query to the communication server from the PCD, wherein the search query includes a request to obtain information related to the specific product (see column 3, line 45 to column 4, line 4);

d) processing the search query to obtain the product related information from one or more of the multiple remote databases (see e.g. column 4, lines 23-43);

e) responding to the search query by sending the product related information from the communication server to the PCD(see column 3, line 45 to column 4, line 4); and

f) displaying at least a portion of the product related information

n on the PCD (see column 3, line 45 to column 4, line 4).

Re claim 8, examiner finds that the database of codes taught by Perkowski is a code library.

Re claims 11-13, Perkowski teaches that product reviews may be provided.

Claims 1, 4-11, 18-21 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent #5,869,819 to Knowles et al. ("Knowles" hereinafter). Knowles discloses method of obtaining information related to a specific product from multiple remote databases accessible over the Internet via a communications server using a personal communication device (PCD), said PCD having a display and means for communicating with the communication server, the method comprising the steps of:

a) entering product information (see e.g. column 15, lines 10-40, and elsewhere) into said PCD (see e.g. figure 1);

b) transmitting the product information to the communication server from the PCD (see figure 1);

c) transmitting a search query to the communication server from the PCD, wherein the search query includes a request to obtain information related to the specific product (see e.g. column 15, lines 10-40, and elsewhere);

d) processing the search query to obtain the product related information from one or more of the multiple remote databases (see column 8, lines 27-54);

e) responding to the search query by sending the product related information from the communication server to the PCD (see, e.g. column 12, lines 21-54); and

f) displaying at least a portion of the product related information on the PCD (see, e.g. column 12, lines 21-54).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 12-16 are rejected under 35 U.S.C. § 103 as being unpatentable over Perkowski. Perkowski teaches the features of the invention as described above, and further teaches that pricing information may be obtained in the inventive method. Perkowski does not seem to directly teach that competitive pricing information may be obtained using the Perkowski

invention. Perkowski does, however, state that the prior art is used to obtain competitive information. See column 2, line 57 - column 3, line 17. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to provide competitive pricing information in the Perkowski invention as taught in Perkowski because Perkowski provides pricing information, and comparison pricing is taught by Perkowski to be "critical market information" (col. 2, line 66).

Re claims 12-13, browsing the Internet is notoriously old and well known as an iterative process. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to formulate a second query in response to the displayed product related information because the displayed product information may have html links embedded therein, and the user will presumably want such information and request it using the provided links. This is what the Internet is all about, as anyone skilled in the art understands. Official Notice is taken that a "buy" html tag is old and well known in the art. See In Re Malcolm 1942 C.D.589:543 O.G. 440. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to provide a "buy" tag in response to a user request for product information, and for the user to press the "buy" html tag to purchase the information, because this is presumably one of the things buyers and sellers wish to do when a buyer provides product information to a seller who requests it, as is obviously apparent from Perkowski as it would be understood by one skilled in the art.

Claims 2 and 22 are rejected under 35 U.S.C. § 103 as being unpatentable over Knowles in view of U.S. Patent #6,282,433 to Holshouser ("Holshouser" hereinafter). Knowles discloses the features of the invention as described above, and further teaches a PCD connected to a cellular station, but does not disclose that the PCD is a cellular "phone". Holshouser teaches that a cellular phone can be a web browser, and further that it can contain standard ports (32, 34) which can connect to a bar code reader, as taught in Knowles. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to use the client station of Holshouser as the PCD taught in Knowles, and connect it to a bar code reader through one of the serial ports, so as to facilitate the functionality of Knowles while allowing the user to have

cellular telephone capabilities as taught in Holhouser because this would allow the user to both make phone calls to inquire further about information retrieved on the web, or for any other purpose for which phone calls are useful.

Claim 3 is rejected under 35 U.S.C. § 103 as being unpatentable over Perkowski in view of U.S. Patent #6,061,738 to Osaku et al. Perkowsk teaches the features of the invention as described above, but fails to teach the use of OCR. Osaku teaches that OCR can be used as an equivalent input to bar code readers, keyboards, etc. See figure 9. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to use OCR with Perkowski as taught by Osaku because OCR performs substantially the same function (automatically reading in written information) in substantially the same way (using an optical input and automatic processing) to obtain substantially the same result (the information is input into the computer, and turned into a request for information).

Claims 17 and 23 are rejected under 35 U.S.C. § 103 as being unpatentable over Knowles as modified by Holshouser, further in view of Perkowski. Knowles as modified by Holshouser teach the features of the invention as described above, but fail to teach the provision of competitive pricing information. Perkowski teaches the provision of competitive pricing information, as described above. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to use the Knowles an Holshouser inventions to retrieve competitive pricing information over the web, because Knowles teaches that virtually any information available on the web can be retrieved using the invention, and Perkowski teaches that competitive pricing information is "critical market information", and because a user wanting to retrieve market information would want to retrieve critical market information.

Remarks

Applicant's first claim would cover using Netscape to retrieve product information from Yahoo! and display it, a common activity prior to the time of the invention.

Response to Arguments

Applicant's arguments filed 10/11/02 have been fully considered but they are not persuasive. Applicant asserts that Perkowski fails to meet the recited claim limitations because Perkowski fails to teach or suggest the limitation of transmitting a search query to the communication server as recited in claim 1, or of communicating product information and a search query to the communication server as recited in claim 18. The Examiner respectfully disagrees. Throughout the specification of Perkowski, the sending of information from the PCD to the server is expressly characterized as a "search". See the abstract; column 3, line 60; column 4, line 6; column 4, line 65; column 5, line 10; column 14, line 52; column 15, line 10; and column 16, line 24. The process is also expressly referred to as a query; see column 14, line 51; column 15 line 32; column 15 line 64; column 16, line 38. Examiner maintains that the product retrieval process taught by Perkowski includes a search query. Applicant fails to distinguish over Perkowski by asserting that Perkowski performs a "lookup in the relational database" and not a search query is unpersuasive. Further, Applicant's attempt to distinguish the claimed invention is unpersuasive because of the language chosen to claim the invention. "Information related to the specific product" includes a URL pointing to a product web site. In addition, Figures 2A1 and 2A2 clearly show that the IP/SN database contains more than simply a URL, so that IPSI registrants may provide product information, as well as product related information, to the IP/SN database for responses to IPSI queries.

Applicant also asserts for similar reasons that Knowles fails to anticipate claims 1 and 18. Examiner disagrees for similar reasons. The URL encoded bar code symbols are a search query in Knowles. The reference meets the claim limitations, as stated.

Since the remainder of the arguments depend on the sufficiency of the arguments above, Examiner is unpersuaded of the allowability of any of the dependent claims.

Applicant did not address the Examiners remarks in the previous Office Action.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Voice

Inquiries for the Examiner should be directed to Mark Tremblay at (703) 305-5176. The Examiner's regular office hours are 10:30 am to 7:00 pm EST Monday to Friday. Voice mail is available. If Applicant has trouble contacting the Examiner, the Supervisory Patent Examiner, Michael Lee, can be reached on (703) 305-3503. Technical questions and comments concerning PTO procedures may be directed to the Patent Assistance Center hotline at 1-800-786-9199 or (703) 308-4357.

MARK TREMBLAY
PRIMARY EXAMINER

December 16, 2002